

REMARKS/ARGUMENTS

Claim Rejections

The present application includes pending claims 1-31, all of which have been rejected. The dependent claims 9, 10, 19, 20, 29, and 30 have been amended, as set forth above, to clarify the antecedent language used in these claims. The Applicants respectfully submit that the claims define patentable subject matter.

Initially, the Applicants note that a goal of patent examination is to provide a prompt and complete examination of a patent application:

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the *initial review* of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, Office personnel *should* state *all* reasons and bases for rejecting claims in the *first* Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, Office personnel should indicate how rejections may be overcome and how problems may be resolved. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

Manual of Patent Examining Procedure (MPEP) § 2106(II). As such, the Applicants assume, based on the goals of patent examination noted above, that the **present** Office Action has set forth “all reasons and bases” for rejecting the claims.

The claims 1-31 have been rejected under 35 U.S.C § 103(a) as being as being unpatentable over Knox et al (U.S. 2003/0158928; hereinafter refer as “Knox”) in view of Liwerant et al (U.S. 2005/0246752; hereinafter refer as “Liwerant”). The Applicants respectfully traverse these rejections and request reconsideration of the claims at least for the reasons previously set forth during prosecution and in view of the following remarks:

Claim Rejections under 35 U.S.C. § 103(a)

With regard to an obviousness rejection, MPEP 2142 states that in order for a *prima facie* case of obviousness to be established, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Further, MPEP 2143.01 states that “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination,” and that “although a prior art device ‘may be capable of being modified to run the way the apparatus is claimed, there must be a *suggestion or motivation in the reference to do so*’” (citing *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)). Moreover, MPEP 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion...,” citing *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999).

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Rejection of claims 1, 11, and 21 under 35 U.S.C. § 103(a)

The Office Action asserts that the claims 1, 11, and 21 are rejected under 35 U.S.C § 103(a) as being unpatentable over Knox in view of Ligerant. Claims 1, 11, and 21 are independent claims.

The Applicants agree with the Office Action that Knox does not disclose the causing a "display of a plurality of quality of service options corresponding to said at least one media file" for selection by a remote user." See Office Action, pp. 3-4. Additionally, the Applicants respectfully submit that Ligerant does not teach "causing a display of a plurality of quality of service options corresponding to said at least one media file for selection by a remote user" as stated in part in the claims 1, 11, and 21. (Emphasis added). Rather, Ligerant teaches using a VideoShare Producer 20 software program that is resident on the user's home computer system 10 (second device) where the user is local to the home computer system 10, not a remote user. See page 2, para [0034]; page 3, para [0035], [0039]; page 4, para [0049] ; page 10, para [0127], [0128].

Neither does Ligerant teach causing a display of a plurality of quality of service options "for selection by a remote user." (Emphasis added.) Instead, Ligerant teaches "operating" the VideoShare Producer 20 software "under his control on his computer, in the home computer system 10." See page 2, para [34]; page 4, para [41]; page 5, para [57].

Moreover, Ligerant does not disclose a remote user selecting from a "display of quality of service options corresponding to said at least one media file." Ligerant instead discloses allowing a local user to change "configuration of the audio, video, and compression devices" through the use of "Settings" tab 1110. Page 10, para [127]

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(emphasis added). Lixerant further discloses how the local user can change the properties of the currently selected audio and video device using "Video Settings . . . 1160" and "Audio Settings . . . 1170." Page 10, para [128], lines 20-22 (emphasis added).

Based on at least the foregoing, Applicants believe the rejection of the independent claims 1, 11, and 21 under 35 U.S.C. § 103(a) over Knox in view of Lixerant has been overcome and respectfully requests that the rejection be withdrawn. Additionally, since the dependent claims 2-10, 12-20, and 22-31 depend on the independent claims 1, 11, and 21, respectively, the Applicants respectfully request that the rejection of these claims also be withdrawn. Applicant respectfully reserves the right to argue additional reasons that support the allowability of claims 1-31 should that need arise in the future.

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CONCLUSION

Based on at least the foregoing, Applicants believe that all claims 1-31 are in condition for allowance. If the Examiner disagrees, Applicants respectfully request a phone interview, and requests that the Examiner telephone the undersigned at 312-775-8000.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously requested.

Respectfully submitted,



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